

REMARKS**I. General**

The issues raised by the present Office Action include:

- Claims 1-6, 8, 12-16, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Abboud, U.S. Pat. No. 6,636,958 (hereinafter *Abboud*), in view of Schubert, U.S. Pat. No. 6,742,034 (hereinafter *Schubert*); and
- Claims 7, 9-11, 16, 17 and 19-21 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of *Abboud* and *Schubert*, and further in view of Darago, U.S. Pat. No. 6,606,664 (hereinafter *Darago*).

Applicant hereby traverses the outstanding rejections of the claims, and requests reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. The first paragraph of the specification is amended above to include the serial number or patent numbers of the cited related applications incorporated by reference. Claim 18 has been amended to correct a typographical error. As amended, claim 18 depends from immediately preceding independent claim 17, rather than erroneously depending from claim 14, as originally indicated. Claim 18 has only been amended for the purpose of correcting a typographical or administrative error, and not for a substantial reason related to patentability. No new matter has been added by this amendment. Claims 1-23 remain pending in this application.

II. Rejections under 35 U.S.C. § 103(a)

As noted, claims 1-6, 8, 12-16, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Abboud*, in view of *Schubert*; and claims 7, 9-11, 16, 17 and 19-21 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of *Abboud* and *Schubert*, in view of *Darago*. Applicant respectfully traverses these rejections for the reasons advanced below.

A. Examiner's Personal Knowledge

In the rejection of claim 1, the Office Action, on page 2, states "Schubert teaches the disabling of these elements, which effectively disallows access to these elements" (emphasis added). Also, in addressing claim 4, the Office Action, on page 3 states; " Official notice is taken that the charging of customers for storage space is well known in the art." In addressing claim 6, also on page 3, the Office Action states: "It would have been obvious to one of ordinary skill in the art at the time of the invention to specifically include the limitation that the end users are customers of the storage service provider." In addressing claim 9, the Office Action, on page 6, states "It would have been obvious to one of ordinary skill in the art to include the distinction that availability is controlled by the licenses." In addressing claim 10, the Office Action, on page 6, states: "It would have been obvious to one of ordinary skill in the art at the time of the invention to block users not having licenses." In addressing claim 11, the Office Action, on page 12, states "It would have been obvious to one of ordinary skill in the art at the time of the invention to include the ability to purchase further access rights." In addressing claim 12, on page 4, the Office Action states: "It would have been obvious to one of ordinary skill in the art to include the existence of the data library on the premises of the users, as in a computer system, where the user is located at the client computer, and the data library is also located at the same computer." In addressing claim 14, the Office Action, on pages 4 and 5 states: "Official notice is taken that the adjustment in a pay-per-use paradigm is well known in the art."

In light of these statements, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to each of the above matters. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertions. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite one or more references in support of the assertions in a non-final Office Action. Otherwise the rejections of at least claims 1, 4, 6, 9, 10, 11, 12 and 14 should be withdrawn.

B. A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicant respectfully asserts that the rejection does not satisfy the first and third criteria.

1. **The recited combination does not teach or suggest all claim elements.**

In addressing claim 1, the Office Action admits that *Abboud* does not teach “disabling of slot and data transfer elements, thus disallowing user access to these elements.” The Office Action attempts to cure this deficiency by introducing *Schubert*, which the Office Action alleges to teach “disabling these elements, which effectively disallows access to these elements.” This combination is relied upon in rejecting independent claim 13 as well, and in combination with *Darago* to reject independent claim 17. However, these combinations do not teach or suggest all elements of the claimed invention.

a. **Claims 1-12**

The preamble of independent claim 1 recites “providing data storage capacity on demand”. The Examiner is respectfully reminded that M.P.E.P. § 2111.02 provides: “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” Thus, Applicant respectfully asserts that claim 1 recites the element “providing data storage capacity on demand.” The Office Action appears, at least with respect to claim 1, to be relying on *Abboud* as teaching this element. Applicant respectfully points out that *Abboud* is directed to a drive partitioning scheme (see title and abstract). Additionally, *Schubert* make no mention of providing data storage capacity on demand, or the like.

Independent claim 1 recites “partitioning at least a portion of a set of active data media storage slot elements and active data transfer elements of said data library, exclusive of said disabled set, into partitions for use by said end users.” The Office Action relies upon *Abboud* as teaching these elements. However, Applicant respectfully asserts that *Abboud* fails to teach or suggest these elements. First, Applicant notes that the Office Action admits

that *Abboud* fails to teach or suggest “disabling of slot and data transfer elements.” Therefore, Applicant fails to understand how *Abboud* can be read to teach or suggest “partitioning ... a set of active data media storage slot elements and active data transfer elements..., exclusive of said disabled set” (emphasis added). Further, Applicant respectfully submits that *Abboud* fails to teach or suggest partitioning a set of active data media storage slot elements and active data transfer elements of a data library. The portion of *Abboud* relied upon by the Office Action as teaching this element merely indicates that a hard drive of an appliance server has more than one partition. *Abboud* is silent concerning partitioning a data library as recited by claim 1.

Claim 1 also recites “redefining said sets in response to changes in storage capacity rights of said end users.” A portion of *Abboud* cited by the Office Action, column 9, lines 52–55, as teaching this element provides:

First application 507 contained in NOS partition 305 may be replaced with second (new) application 509. During normal operation, the application that is currently in NOS partition 305 determines the functionality of the appliance server. Re-provisioning involves the removal of the first application 507 (as well as the associated OS) from the NOS partition 305 and subsequent loading of the second application 509 into NOS partition 305.

Thus, *Abboud* appears to only teach an application change, not redefining sets of active and disabled slot and data transfer elements. Further, *Abboud* is silent as to changes in storage capacity rights of end users, as recited in claim 1 as well.

As noted above, the Office Action relies on *Schubert* as teaching “disabling these elements, which effectively disallows access to these elements.” However, claim 1 recites “disabling a set of slot elements and data transfer elements of a data library” (emphasis added). *Schubert* is silent concerning data libraries. Claim 1 also recites “disallowing access to said disabled set by end users of said library” (emphasis added). In contrast *Schubert*, at column 4, lines 48–53 provides:

When that particular host 12 requests an identification of all available logical storage devices, masking engine 20 then

responds by identifying only the subset. In such a way, the masking engine "masks" other available logical storage devices, preventing the particular host from attempting to take control of the other logical storage devices.

Thus, *Schubert* only teaches masking other available logical storage devices from host 12, not disallowing access to disabled slot and data transfer elements to (all) end users of a data library, as claimed.

Whereas, the combination of *Abboud* and *Schubert* fails to teach or suggest at least the elements discussed above, Applicant respectfully asserts that independent claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2–6, 8 and 12, ultimately depend from independent claim 1, thus each of claim 2–6, 8 and 12 inherits all elements of claim 1. Therefore, for at least the reasons advanced above in addressing the rejection of claim 1, Applicant respectfully asserts that each of claims 2–6, 8 and 12 sets forth features and elements not recited by the combination of *Abboud* and *Schubert*. Thus, Applicant respectfully asserts that claims 2–6, 8 and 12 are patentable over the 35 U.S.C. § 103(a) rejections of record.

Claims 7 and 9–11 are rejected based on the combination of *Abboud*, *Schubert* and *Darago*. In addressing claim 7, the Office Action admits that the combination of *Abboud* and *Schubert* does not teach “keying of the first elements on a license purchased by one of said users.” In an attempt to address this deficiency the Office Action introduces *Darago*, which the Office Action alleges to teach “the licensing of certain groups of services.” However, as noted above the combination of *Abboud* and *Schubert* fails to teach or suggest elements of independent claim 1. Claims 7 and 9–11 ultimately depend from claim 1. *Darago* is not relied upon as teach any of the elements pointed out as missing from the combination of *Abboud* and *Schubert* above. Therefore, the combination of *Abboud*, *Schubert* and *Darago* does not teach all elements of claims 7 and 9–11

b. Claims 13-16

As noted above, the combination of *Abboud* and *Schubert* is employed by the Office Action to reject independent claim 13. Similar to claim 1, the preamble of claim 13 recites

“providing data storage capacity on demand”. Therefore, Applicant respectfully asserts that claim 13 also recites the element “providing data storage capacity on demand.” As noted above, Applicant respectfully contends that neither *Abboud* nor *Schubert* teach or suggest providing data storage capacity on demand, or the like.

Independent claim 13 recites “reserving a set of data media storage slot elements and data transfer elements in a data library for present and future use by a customer.” The Office Action relies on column 3, lines 1–14 of *Abboud* as teaching this element. However, the cited portion of *Abboud* only teaches removing an application and its Operating System (O/S) and storing that application and O/S as an image file in an “image partition” on an appliance server’s hard drive. *Abboud* is silent as to “reserving a set of data media storage slot elements and data transfer elements in a data library for present and future use by a customer” as recited by independent claim 13.

As with claim 1 above, the Office Action relies on *Schubert*, column 8, lines 1–15 and column 4, lines 42–57 as teaching “disabling a subset of said set of slot elements and data transfer elements.” Applicant respectfully asserts that *Schubert* appears to only teach masking logical storage devices from a particular host, see column 4, lines 48–54, not disabling a subset of slot and data transfer elements, as claimed.

Claim 13 also recites “partitioning said reserved set into a subset of said set of slot elements and data transfer elements activated as a partition secured for use by said customer, wherein said subsets are exclusive of one another.” The portion of *Abboud* cited by the Office Action as teaching these elements, column 7, lines 21–36, discusses the partitioning of a hard drive into three partitions. Nothing in this text teaches or suggests partitioning a set of slot and data transfer elements into a subset of slot and data transfer elements activated as a partition secured for use by a customer, much less with the subsets exclusive of one another, as claimed in claim 13.

Finally, independent claim 13 recites “redefining said partition by moving at least one element between said subsets in response to changes in storage capacity needs of said customer.” The portions of *Abboud* cited by the Office Action as teaching this element include the aforementioned discussion of hard drive partitioning and, at column 10, lines 1–

35, discussion of how a graphical interface may be used to re-provision an application stored as an image. Nothing in this discussion teaches or suggests redefining a partition of a data library by moving at least one slot or data transfer element between said subsets of slots and data transfer elements, particularly in response to changes in storage capacity needs of a customer.

Whereas, the combination of *Abboud* and *Schubert* fails to teach or suggest at least the elements discussed above, Applicant respectfully asserts that independent claim 13 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 14–16 depend directly from independent claim 13, thus each of claims 14–16 inherits all elements of claim 13. Therefore, for at least the reasons advanced above in addressing the rejection of claim 13, Applicant respectfully asserts that each of claims 14–16 sets forth features and elements not recited by the combination of *Abboud* and *Schubert*. Thus, Applicant respectfully asserts that claims 14–16 are patentable over the 35 U.S.C. § 103(a) rejections of record.

c. Claims 17-23

As noted above the Office Action relies on a combination of *Abboud*, *Schubert* and *Darago* to reject independent claim 17. The Office Action fails to point out what elements of independent claim 17 *Abboud* and *Schubert* fails to teach. However, the Office Action does allege that *Darago* teaches “keying numbers of said elements in said partitioned set on a license purchased by said customer.” In the event the Examiner does not find the arguments advanced below persuasive, Applicant respectfully requests that the Examiner clarify the rejection of claim 17, in a non-final Office Action so that Applicant may have a full and fair opportunity to assess the patentability of claim 17 and its dependent claims.

The preamble of claim 17 recites “limiting access to data storage capacity in a data library” As mentioned above *Abboud* and *Schubert* are silent concerning data libraries, similarly *Darago* is silent concerning data libraries.

Claim 17, also recites “disabling a set of slot elements and data transfer elements of said data library, disallowing access to said disabled set.” The Office Action again cites

Schubert as teaching this element. As noted above, *Schubert* is silent concerning data libraries, much less disallowing access to a disabled set of slot and data transfer elements of a data library. Finally, as also discussed above, in addressing the rejection of claims 1 and 13, *Schubert* only teaches masking other available logical storage devices from a host, not disallowing access to disabled slot and data transfer elements, as claimed.

Independent claim 17 also recites “partitioning at least a portion of a set of active slot elements and active data transfer elements of said data library into partitions for use by one customer, wherein said sets are exclusive of one another.” As discussed above in address in the rejection of claim 13, *Abboud* discusses the partitioning of a hard drive into three partitions. Nothing in the text of *Abboud* cited by the Office Action teaches or suggests partitioning a set of slot and data transfer elements into a partition for use by one customer, much less with the sets exclusive of one another, as claimed in claim 17.

Finally, independent claim 17 recites “keying numbers of said elements in said partitioned set on a license purchased by said customer.” As noted above, *Darago* is relied upon as teaching this element. However, the portion of *Darago* cited by the Office Action, column 4, lines 15–25, discusses the sale of software and supporting documentation employing license agreement for the use of the software and instructions on a single workstation. Nothing in this text teaches or suggests keying the numbers of slot and data transfer elements in a partition based on a license purchased by a customer, as claimed in claim 17.

Whereas the combination of *Abboud*, *Schubert* and *Darago* fails to teach or suggest various elements of independent claim 17, as detailed above, Applicant respectfully asserts that independent claim 17 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 18, as amended, and claims 19–23, ultimately depend from independent claim 17, thus each of claim 18–23 inherits all elements of claim 17. Therefore, for at least the reasons advanced above in addressing the rejection of claim 17, Applicant respectfully asserts that each of claims 18–23 sets forth features and elements not recited by the combination of *Abboud*, *Schubert* and *Darago*. Thus, Applicant respectfully asserts that claims 18–23 are patentable over the 35 U.S.C. § 103(a) rejections of record.

Further, the Office Action indicates that claim 22 is rejected on the same basis as claim 12. Applicant respectfully points out that claim 22 depends from claim 17. The Office Action admits that the combination of *Abboud* and *Schubert* used to reject claim 12, fails to teach at least one element of claim 17. Whereas, claim 22 inherits all elements of claim 17, Applicant respectfully contends that claim 22 is further patentable over the rejection of record. In the event the Examiner does not find the above arguments persuasive, Applicant respectfully requests that the Examiner clarify the rejection of claim 22, in a non-final Office Action so that Applicant may have a full and fair opportunity to assess the patentability of claim 22.

2. The Office Action does not provide the requisite motivation.

As noted above, while addressing claim 1 the Office Action admits that *Abboud* does not teach “disabling of slot and data transfer elements, thus disallowing user access to these elements.” The Office Action attempts to cure this deficiency by introducing *Schubert*, which the Office Action alleges to teach “disabling these elements, which effectively disallows access to these elements.” The motivation for making the combination and modification was presented as follows:

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the disabling of certain slot elements, which would in turn, disallow access to certain elements, as taught by Schubert in the system of Abboud. The motivation for doing so lies in the fact that if users need extra space, an efficient method to provision this would constitute the disabling of certain resources, so that space is freed up for those users. Both inventions are from the same field of endeavor, namely the intelligent management of computer storage space.

It is well-settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicant’s disclosure. Applicant asserts that without the teachings of Applicant’s disclosure one of ordinary skill in the art would not find it obvious to disable certain storage resources, so that space is freed up for users who need space. Nothing in *Abboud* or *Schubert* teaches or suggests “that if users

need extra space, an efficient method to provision this would constitute the disabling of certain resources, so that space is freed up for those users.” The Examiner seems to be relying on the teachings of the present application to conclude that one of ordinary skill in the art would be motivated to modify the disk drive partitioning system of *Abboud* to employ the disabling asserted by the Office Action as taught in *Schubert*.

Applicant respectfully alleges that the statement “if users need extra space, an efficient method to provision this would constitute the disabling of certain resources, so that space is freed up for those users” is irrelevant and inaccurate. Applicant fails to understand how disabling certain resources would constitute an effective method to provide extra space needed by users. Applicant respectfully asserts that disabling resources typically reduces the amount of space available to users. Thus, at best this statement can only be interpreted as a mere statement that the references can be combined, and does not state any desirability for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the combination and modification.

As to the statement: “Both inventions are from the same field of endeavor, namely the intelligent management of computer storage space,” Applicant respectfully directs the Examiner’s attention to M.P.E.P. § 2143.01, which, citing *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), points out that motivation to combine references to arrive at the claimed invention can be found in the “nature of the problem to be solved” where each reference is directed “to precisely the same problem.” Applicant maintains that while a hard drive is discussed in *Abboud*, and storage resources are mentioned in *Schubert*, these references are not directed “to precisely the same problem,” such as “the intelligent management of computer storage space” as advanced by the Office Action.

Whereas no valid suggestion has been made as to why a combination of *Abboud* and *Schubert* is desirable, absent the application of impermissible hindsight, the rejection of claims 1–6, 8, 12–16, 18 and 22 should be withdrawn.

As also noted above, the Office Action fails to point out what element of independent claim 17 *Abboud* and *Schubert* fails to teach. However, the Office Action in addressing claim 7 alleges that *Darago* teaches “the licensing of certain groups of services.” The motivation for making the combination was presented as follows:

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the ability to license a group of services, as taught by *Darago* in the system of *Abboud-Schubert*. The motivation for doing so lies in the fact that having a license to a specific service would allow protection of those services to users who have paid for it, which thus ensures that only those users that are serious about these services can use them. All inventions are from the same field of endeavor, namely user-driven network provisioning.

As noted, the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. Applicant respectfully alleges that the statement “having a license to a specific service would allow protection of those services to users who have paid for it, which thus ensures that only those users that are serious about these services can use them” is irrelevant and inaccurate. Thus, at best this statement can only be interpreted as a mere statement that the references can be combined, and does not state any desirability for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the combination.

As to the statement: “All inventions are from the same field of endeavor, namely user-driven network provisioning,” Applicant respectfully asserts that this statement is clearly inaccurate and does not meet the burden imposed by M.P.E.P. § 2143.01 and *Ruiz* discussed above. The cited references do not all address “network provisioning” and are not all directed “to precisely the same problem.”

Whereas no valid suggestion has been made as to why a combination of *Abboud* and *Schubert* is desirable, the rejection of claims 7, 9–11, 16, 17 and 19–21 and 23 should be withdrawn.

III. Conclusion

For at least the reasons given above, Applicant submits that the pending claims distinguish over the cited references under 35 U.S.C. § 103. Accordingly, Applicant submits that this application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 30014517-1, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can be helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482708355US, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: May 3, 2005

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